

REMARKS

In response to the non-final office action of June 8, 2004, applicant asks that all claims be allowed in view of the amendment to the claims and the following remarks.

Claims 1-49 are pending, of which claims 1 and 29 are independent claims, and claims 1 and 29 amended by this amendment. No new matter is believed to be added by this amendment.

Rejection of Claims 1-49 Under § 102

Claims 1-49 were rejected under 35 U.S.C. § 102 as being anticipated by Saito (U.S. Patent No. 6,230,964). Applicant requests reconsideration and withdrawal of this rejection because Saito does not describe or suggest a compact disk case having a viewing window that exposes a portion that is less than all of the surface of a disk inserted in the compact disk case.

With regard to amended independent claim 1, a compact disk case is recited that includes, *inter alia*, a first side that is structured and arranged to define a viewing window that constitutes less than all of the first side to provide a first viewing characteristic that differs from a second viewing characteristic that is provided through another portion of the first side. The viewing window exposes a portion that is less than all of the surface of a disk inserted into the compact disk case.

Saito describes a protruding case for mail that has a cut-out window portion on one side to expose contents of the case. See Saito at col. 1, line 1; col. 10, lines 23-44; FIGS. 12(a)-(b), and FIGS. 17(a)-(c). In one implementation, Saito's protruding case is designed such that a sample of an article can be mailed along with various types of literature. See Saito at col. 1, lines 39-47. The article is placed in a transparent cup that protrudes out from the sealed mail case through an opening in one side of the mail case. See Saito at col. 2, lines 15-30. The transparent cup and its contents can be viewed through the first side of the case. See Saito at col. 11, lines 10-31. See e.g., FIGS. 12(a) and 12(b). Saito discloses another implementation in which the postal matter case is used for mailing a compact disk. See Saito at col. 11, line 46 to col. 12, line 33 and FIGS. 15-16(b). In this implementation, Saito discloses a postal matter case that includes a disk-shaped cup, which may be made using clear colorless material. See Saito at col. 11, lines 55-63. A disk is placed in a disk-shaped inner space of the transparent disk-shaped cup. See

Saito at col. 11, lines 55-57 and col. 12, lines 16-25. As such, the entire surface of the disk is exposed through a transparent disk-shaped cup of Saito.

The Office action seems to correlate the postal matter case of Saito to the claimed compact disk case, and the transparent disk-shaped cup of Saito to the viewing window of claim 1. As such, Saito fails to describe or suggest a compact disk case having a viewing window that exposes a portion that is less than all of the surface of a disk inserted in the compact disk case. Rather, in Saito, the entire surface of the disk is exposed through the transparent disk-shaped cup (i.e., viewing window), as described above.

Stated differently, Saito does not describe or suggest a viewing window providing a first viewing characteristic that differs from a second viewing characteristic that is provided through another portion of the first side of the compact disk case and exposing a portion that is less than all of the surface of a disk inserted in the compact disk case.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of independent claim 1 and dependent claims 2-28.

With regard to amended independent claim 29, claim 29 recites a method of distributing marketing materials stored as data on compact disk in a case having substantially the same features as recited in claim 1. For the reasons described above with respect to claim 1, Saito fails to describe or suggest the method of distributing marketing materials stored as data on a compact disk having substantially the same features as recited in claim 1.

Therefore, for at least the reasons described above with respect to claim 1, applicant requests reconsideration and withdrawal of the rejection of independent claim 29 and claims 30-49 that depend on claim 29.

Rejection of Claims 1-23 and 29-44 Under § 103

Claims 1-23 and 29-44 were rejected under 35 U.S.C. § 103 as being unpatentable over Flores (U.S. Patent No. 6,454,090) in further view of the Examiner's Official Notice that "it is old and well known in the art of mailing or packaging to provide different viewing windows." See Office action of June 8, 2004 at page 5. Applicant requests reconsideration and withdrawal of the rejection because neither Flores alone, nor in combination with the Official Notice, describes or suggests a compact disk case having a viewing window constituting less than all of

the first side to provide a first viewing characteristic that differs from a second viewing characteristic provided through another portion of the first side, as recited in independent claims 1 and 29.

Flores describes a compact disk storage case where the entire first side “comprises a transparent window 116 such that either the cover or a front page of the pamphlet, brochure, booklet or the like may be viewed when the disc storage container is closed.” See Flores at col. 7, lines 8-13 and FIG. 6, element 116. As such, Flores does not describe or suggest a first side of the compact disk case that includes a viewing window that constitutes less than all of the first side. Because the viewing window of Flores constitutes the entire first side of the compact disk case, this viewing window only provides one viewing characteristic. See Flores at col. 7, lines 8-13 and FIG. 6, element 116. This is because Flores merely describes a first side of the case that “comprises a transparent window” through which “either the cover or a front page of [a] pamphlet, brochure, booklet or the like” may be viewed. See Flores at col. 7, lines 9-13 (emphasis added). Since Flores only contemplates viewing one item at a time (either the cover or the front page of a booklet) through a single viewing window, the viewing window does not provide a first viewing characteristic that differs from a second viewing characteristic. Accordingly Flores does not describe or suggest a viewing window that provides a first viewing characteristic that differs from a second viewing characteristic provided through another portion of the first side.

Moreover, Flores' disk storage case exposes for viewing all of the surface of the disk. Thus, Flores does not describe or suggest a compact disk case having a viewing window that exposes a portion that is less than all of a surface of a disk inserted into the compact disk case, as recited in claims 1 and 29.

The Examiner's Official Notice that “it is old and well known in the art of mailing or packaging to provide different viewing windows” does not cure this deficiency in Flores' compact disk case because Flores is not part of the art of mailing or packaging. Assuming *arguendo* that the Examiner's Official Notice could be combined with Flores, even so, the Examiner's Official Notice does not describe or suggest that a portion that is less than all of the disk surface exposed through a mailing window. Accordingly, the Examiner's Official Notice does not cure the failure of Flores to describe or suggest a compact disk case having a viewing

window that exposes a portion that is less than all of a surface of a disk inserted into the compact disk case.

For at least these reasons, Applicant respectfully request withdrawal of this rejection of independent claims 1 and 29 and their dependent claims 2-23 and 30-44.

Rejection of Claims 24-28 and 45-49 Under § 103

Claims 24-28 and 45-49 were rejected under 35 U.S.C. § 103 as being unpatentable by Flores in view of Saito. Applicant requests reconsideration and withdrawal of the rejection because neither of Flores, Saito, nor any combination of the two describes or suggests a compact disk case having a viewing window that exposes a portion that is less than all of the surface of a disk inserted into the compact disk case, as recited in claims 1 and 29, from which claims 24-28 and 45-49 depend, respectively.

With respect to independent claims 1 and 29, as discussed above, each of Saito and Flores fail to show all elements recited in claims 1 and 29. In particular, Saito and Flores each fail to show a compact disk case having a viewing window that exposes a portion that is less than all of a surface of a disk inserted into the compact disk case, as claimed. As such the combination of Saito and Flores cannot suggest an element that is missing from both the references. Thus, the combination of Saito and Flores necessarily cannot describe or suggest a compact disk case having a viewing window that exposes a portion that is less than all of a surface of a disk inserted into the compact disk case because the constituent references of Saito and Flores each fail to show that feature.

Therefore, neither Saito, Flores, or any combination of the references discloses or suggests a compact disk case having a viewing window that exposes a portion that is less than all of the surface of a disk inserted in the compact disk case, as recited in claim 1 and 29.

For at least these reasons, applicant respectfully requests reconsideration and withdrawal of the rejection of claims 24-28 and 45-49 that depend from claims 1 and 29, respectively.

Double Patenting Rejection

Claims 1 and 29 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of co-pending Application

No. 09/964,455. A terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) is being filed concurrently with this amendment. Therefore, for at least this reason, applicant respectfully requests reconsideration and withdrawal of the provisional rejection of claims 1 and 29.

Rejection Under § 101

Claims 29-49 have been rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter as being not within the technological arts. Applicant respectfully traverses the rejection because the claims are directed to statutory subject matter, which is not limited to technological arts.

Claim 29 is directed to a method of distributing marketing materials that, includes obtaining a compact disk on which marketing materials are stored as data; installing the compact disk in a case having particular characteristics; and mailing the case containing the compact disk to an intended recipient.

The Examiner bases the rejection of claim 29 on a two-prong test of (1) whether the invention is within the technological art; and (2) whether the invention produces a useful, concrete, and tangible result. See Office action of June 8, 2004 at page 3. The Examiner found that the claimed invention produces a useful, concrete and tangible result and found that the claimed process does not require structural interaction or mechanical intervention, and, as a consequence, did not fall within the technological arts. See Office action of June 8, 2004 at page 3, line 18-20 and page 4, lines 4-6. The Examiner seems to be applying guidelines for determining patentability of a computer-related process. See MPEP § 2106 IV.B.2.(b)(i) at page 2100-17. However, claims 29-49 recite a physical process outside of a computer and, therefore, are not related to a process performed by a computer and subject to such guidelines.

Moreover, 35 U.S.C. § 101 defines the subject matter that is patent-eligible as “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” See MPEP § 706.03(a). A process is further defined as a “process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.” See MPEP § 706.03(a). Because claims 29-49 set forth a method of distributing marketing materials, the claims are to a process and therefore satisfy the requirements of 35 U.S.C. § 101.

Applicant : Kristin Carman
Serial No. : 09/750,028
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Page : 15 of 15

Attorney's Docket No.: 06975-139001 / Packaging 01

Therefore, for at least these reasons, applicant requests reconsideration and withdrawal of the rejection of independent claim 29 and claims 30-49 that depend from claim 29.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

No fee is believed due. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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Barbara A Benoit
Barbara A. Benoit
Reg. No. 54,777

Customer No.: 26171
Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331